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Patent  
Customer No.: 022870  
Docket No.: 14690.002USB

UNITED STATES PATENT AND TRADEMARK OFFICE  
PATENT OPERATIONS

Applicant: Myerson et al.

Application No.: 10/056490

Filing Date: 24 January 2002

Title: Method For Producing Crystal  
Polymorphs and Crystal Polymorphs  
Produced Thereby

Art Unit: 1654

Examiner: Russel, J.

PETITION UNDER 37 CFR 1.182

14 May 2004

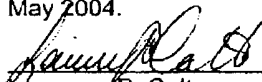
Via Fax: +1.703.872.9306

Mail Stop Petition - Fee  
Commissioner of Patents  
PO Box 1450  
Alexandria VA 22313-1450

Sir:

Applicant is filing this Petition under 37 CFR 1.182 because Applicant believes it raises a question not specifically provided for. The petition fee of \$130.00 under 37 CFR 1.17(h) is enclosed by way of a Form PTO-2038.

I certify that I have transmitted this document via facsimile to the USPTO at 703.872.9306, this 14<sup>th</sup> day of May 2004.

  
Laurence P. Colton

### **BACKGROUND**

Applicant filed the above captioned patent application on 24 January 2002. In the **original** patent application papers filed on 24 January 2002, Applicant included the following cross-reference to related applications:

### **CROSS-REFERENCE TO RELATED APPLICATION**

The present application is a continuation of US patent application no. 09/694404, filed on 23 October 2000, currently pending, which is a continuation-in-part of US patent application no 09/348200, filed on 6 July 1999, abandoned.

In the **first** Office Action dated 6 May 2003 the examiner objected to the characterization of the patent application as a continuation and required Applicant to amend the priority data to indicate that the patent application was a continuation-in-part. This first Office Action was dated almost 16 months after the filing date of the patent application (far more than the 4-month period set forth in 37 CFR 1.78(a)(2)) and more than 30 months after the filing date of the parent patent application (far more than the 16-month period set forth in 37 CFR 1.78(a)(2)). In response to this Office Action, on 5 September 2003 Applicant amended the priority claim to characterize the patent application as a continuation-in-part.

In the **second** Office Action dated 2 January 2004 the examiner did not enter the amendment to the priority claim as it was now more than 4 months from the filing date of the patent application and more than 16 months from the filing date of the priority patent application.

In the **third** Office Action dated 7 May 2004 the examiner again did not enter the amendment to the priority claim as for the same reason given in the second Office Action.

### **ISSUE PRESENTED**

Whether the time periods set forth in 37 CFR 1.78(a)(2) should be applied in the present circumstances.

### DISCUSSION

Applicant has filed this Petition under 37 CFR 1.182 regarding the amendment to Applicant's claim of priority. Applicant has filed the Petition under 37 CFR 1.182 rather than under 37 CFR 1.78(a)(3) because it is Applicant's position that because Applicant did **originally** claim priority in the original patent application papers by referencing the priority application by application number and filing date, and merely changed the type of priority from a "continuation" to a "continuation-in-part" at the request of the examiner, Applicant has not "presented" this claim for priority after the time period provided by 37 CFR 1.78(a)(2) so as to entail the need for a petition under 37 CFR 1.78(a)(3) and the significant fee under 37 CFR 1.17(t).

37 CFR 1.78(a)(2) provides in relevant part that:

(2)(i) Except for a continued prosecution application filed under Sec. 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see Sec. 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application.

The original application papers did "contain ... a reference to each such prior filed application", did "identify[] it by application number (consisting of the series code and serial number)", and did "indicat[e] the relationship of the applications" as required under 37 CFR 1.78(a)(2)(i). When the examiner required an amendment to the priority claim to indicate that the patent application was a continuation-in-part rather than a

continuation (with which Applicant generally disagrees), Applicant amended the application papers to change the relationship, as allowed under 37 CFR 1.78 (a)(2)(i).

Applicant submits that Applicant complied with the letter of the law of 37 CFR 1.78(a)(2)(i) and certainly with the spirit of 37 CFR 1.78(a)(2)(i) in that Applicant provided a proper reference to the parent patent application and in a good faith belief considered the patent application to be a continuation of the parent patent application.

Further, as the examiner's requirement to amend the relationship was not made until after "the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application" as required under 37 CFR 1.78(a)(2)(ii), Applicant could not possibly have made the amendment to the relationship during the time periods set forth. However, as the first Office Action had been issued within the first four months following the filing of the patent application, Applicant could have made a timely amendment to the relationship.

Applicant submits that the provisions of 37 CFR 1.78(a)(3) do not apply in this situation. The patent application contained a proper reference to the parent patent application, and indicated a continuation relationship, which Applicant believes is correct. The relationship was amended as allowed only at the request of the examiner. This is not a situation in which Applicant (1) did not have a priority claim in the original application papers, (2) made a priority claim to an incorrect parent patent application, or (3) listed an incorrect parent application number. The priority claim made by Applicant was clear and the parent completely described.

#### **RELIEF REQUESTED**

Applicant requests the following relief:

1. That the Commissioner direct the examiner to enter Applicant's amendment to the relationship of the parent patent application as indicated in Applicant's Response papers dated 5 September 2003;
2. That the Commissioner hold and find that the amendment under the present fact scenario is appropriate under 37 CFR 1.78(a)(2)(i) and does not invoke the time periods set forth under 37 CFR 1.78(a)(2)(ii);

3. That the Commissioner hold and find that the amendment under the present fact scenario does not invoke the petition requirement under 37 CFR 1.78(a)(3); and

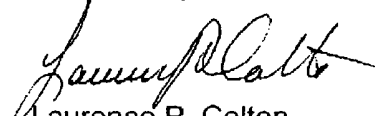
4. That the Commissioner refund the Petition Fee enclosed herewith as not being required due to the findings resulting from this petition being a clarification of the Patent Rules.

### CONCLUSION

Applicant requests that Applicant's "Relief Requested" be GRANTED and that Applicant's petition be declared unnecessary as a clarification of the Patent Rules or in the alternative be GRANTED.

If the Commissioner has any questions or needs any further information, please contact the below signed patent attorney of record.

Respectfully submitted,

  
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